

## REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed January 3, 2003. Upon entry of the amendments in this response, claims 1 – 29 are pending. In particular, Applicant has added new claims 27 – 29. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

### I. Replacement Drawings Comply with 37 C.F.R. §1.84

The Office Action objects to the drawings as failing to comply with 37 C.F.R. §1.84 because the drawings did not include several reference numerals mentioned in the specification. Applicant respectfully submits that 37 C.F.R. §1.84 does not require that all reference numerals mentioned in the specification must be present in the drawings. Nonetheless, Applicant submits the replacement drawings in which various typographical errors have been corrected. Specifically, Applicant has amended both the drawings and the specification so that the elements illustrated in the drawings are accurately identified in the specification. Therefore, Applicant respectfully submits that the replacement drawings do comply with 37 C.F.R. §1.84 and, accordingly, requests that this objection to the drawings be withdrawn and the replacement drawings approved.

The Office Action also objects to the drawings as failing to comply with 37 C.F.R. §1.84 because the drawings include several reference numerals that are not mentioned in the specification and because several elements identified in the specification do not actually refer to the elements in the referenced figure. Applicant thanks the Examiner for her diligence in identifying these typographical errors. As mentioned above, these and other typographical errors have been corrected in the replacement drawings. Specifically, Applicant has amended both the drawings and the specification so that the elements illustrated in the drawings are accurately identified in the specification. Therefore, Applicant respectfully submits that the

replacement drawings do comply with 37 C.F.R. §1.84 and, accordingly, requests that this objection to the drawings be withdrawn and the replacement drawings approved.

## II. Informalities in Specification Corrected

The Office Action objects to the specification due to several informalities. The informalities have been corrected in the substitute specification. Therefore, Applicant respectfully requests that the Examiner withdraw the objection to the specification.

## III. Informalities in Claims Corrected

The Office Action objects to claim 1 because of an informality. As illustrated above, claim 1 has been amended to correct this informality. Therefore, Applicant respectfully requests that the Examiner withdraw the objection to claim 1.

## IV. Claims 1 – 5, 7 – 16, 19 – 23, and 26 are Patentable Over U.S. Patent No. 5,907,491 in view of U.S. Patent No. 6,141,347

The Office Action rejects claims 1 – 4, 7 – 16, 19 – 23, and 26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,907,491 to Canada *et al.* (“the ‘491 patent”) in view of U.S. Patent No. 6,141,347 to Shaughnessy *et al.* (“the ‘347 patent”). Specifically, the Office Action argues that the ‘491 patent teaches all of the claimed features of independent claims 1, 8, 13, and 20 except for a wide area network and a predefined communication protocol. Furthermore, the Office Action argues that the additional features of dependent claims 2 – 5, 7, 9 – 16, 19, 21 – 23, and 26 are each taught by the ‘347 patent and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of the ‘491 patent to include these features that are allegedly taught by the ‘347 patent.

Applicant respectfully submits that this rejection under §103 should be withdrawn for any of the following reasons, each of which are separately discussed below:

(A) the Office Action fails to establish a prima facie case of obviousness because the Examiner has not established the proper suggestion or motivation to combine the '491 patent and the '347 patent in the manner suggested; and

(B) the Office Action fails to establish a prima facie case of obviousness because, even assuming a proper suggestion or motivation to combine has been established, the combined teachings of the '491 patent and the '347 patent do not teach all of the claim limitations.

A. Prima Facie Case of Obviousness Not Established: No Suggestion or Motivation to Combine References as Suggested

The rejection of claims 1 – 4, 7 – 16, 19 – 23, and 26 under 35 U.S.C. §103(a) should be withdrawn because the Examiner has failed to establish a prima facie case of obviousness. In order to establish a prima facie case of obviousness by combining references, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill, to modify the primary reference (the '491 patent) in the manner allegedly taught by the secondary reference (the '347 patent). *See e.g.*, MPEP §§2142, 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant respectfully submits that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the alleged teaching of the '491 patent with the alleged teaching of the '347 patent such as to render obvious claims 1 – 4, 7 – 16, 19 – 23, and 26.

In fact, Applicant respectfully submits that the '347 patent is improper "nonanalogous art" that may not be relied upon to support a prima facie case of obviousness. In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must be either in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. MPEP §2141.01(a); *See, In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

The '491 patent relates to localized systems for monitoring physical characteristics, such as vibration or temperature, of industrial machines within a manufacturing plant and transmitting sensed data to a central command station located within the manufacturing plant for monitoring. Col. 2, ll. 23 – 39; col. 1, l. 17 – col. 2, l. 19. The '491 patent states that the disclosed invention solved the cost and maintenance problems associated with other wired-type localized machine monitoring systems. It should be noted that the systems disclosed in the '491 patent were very simple communication systems in which the central command station polled the machine monitors for data as needed. The '491 patent, therefore, was mainly related to adding a simple wireless capability to existing systems for monitoring complex industrial machines by a command station within the manufacturing plant to improve cost, installation, and maintenance.

The '347 patent, however, relates to global mobile wireless telecommunications systems such as Global System for Mobile Communications (GSM) and Advanced Mobile Phone Service (AMPS) – *not* localized wireless monitoring systems. More specifically, the '347 patent involves a distributed approach to mobility processing. The '347 patent explains that mobility processing relates to various processing functions within global wireless

telecommunications systems for managing the movement of subscribers (*e.g.*, cellphone users) as they move between sites (*e.g.*, cells supported by a cell tower).

Unlike the '491 patent (which involves solving maintenance, cost, and installation problems in a local and very simple polling-type monitoring system), the '347 patent involves solving the very complex problems associated with managing the movement of mobile subscribers between coverage areas in complicated global telecommunications networks. Clearly, one of ordinary skill in the art of local polling-type monitoring systems for manufacturing plants would not look for cost reduction solutions related to maintenance and installation in the complex field of multicast addressing schemes in mobile telecommunications systems. In fact, Applicant respectfully submits that such solutions are not disclosed at all in the '347 patent. Therefore, Applicant respectfully asserts that the '347 patent is improper "nonanalogous art" that may not be relied upon to support a rejection under §103. Accordingly, Applicant respectfully requests that the rejection be withdrawn and claims 1 – 4, 7 – 16, 19 – 23, and 26 be allowed.

Even though Applicant believes the §103 rejection is improper because the '347 patent is unavailable "nonanalogous art," Applicant further submits that the Office Action fails to establish a proper motivation or suggestion to modify the alleged teaching of the '491 patent with the alleged teaching of the '347 patent such as to render obvious claims 1 – 4, 7 – 16, 19 – 23, and 26.

The Office Action rejects independent claims 1, 8, 13, 20, and 27, as well as many other dependent claims, based on the same argument. Nonetheless, Applicant respectfully submits that the scope of these claims are not co-extensive. In the interests of brevity, however, Applicant addresses the similar rejection of all of the independent claims by pointing out the Examiner's failure to establish the proper suggestion or motivation to

combine the WAN and predefined communication protocol of the '347 patent with the local monitoring system of the '491 patent.

Specifically, the Office Action argues that the '491 patent discloses all of the elements of independent claims 1, 8, 13, 20, and 27 except for a wide area network and a predefined communication protocol, which the Office Action alleges are disclosed in the '347 patent. The Office Action further argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the '491 patent to include the alleged teachings of the '347 patent (wide area network and predefined communication protocol) because "connecting the system to a WAN and transmitting using a predefined protocol allows the skilled artisan to distribute processing which will increase scalability (see Shaughnessy et al., column 2 lines 45 – 49)."

It is well-established law that, in order to properly combine select elements from differing prior art sources, there must be some teaching or suggestion *within the prior art* to make the combination specifically claimed by the Appellant's invention. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." ***Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure...*** In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

It has often been noted that, "[h]umans must work with old elements, most if not all of which will normally be found somewhere in an examination of the prior art." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1549, 220 U.S.P.Q. 193 (Fed. Cir. 1983). Furthermore, that features, even distinguishing features, are "disclosed" in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Id.*

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest **both** the combination of elements **and** the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements.

Applicant respectfully submits that the purported motivation or suggestion provided by the Office Action is a classic example of impermissible hindsight reasoning based solely on Applicant's disclosure. In fact, Applicant submits that the purported motivation ("to distribute processing which will increase scalability) quoted from the '347 patent is entirely inapplicable to the localized systems disclosed in the '491 patent for monitoring industrial machines within a manufacturing plant. In the '347 patent, the objective of distributing processing and increasing scalability is achieved by including a connectionless packet network 201 which supports multicast addressing between existing sites 203 – 208. WAN 230, LANs 231 – 232, and the corresponding wireless communication protocol function to

facilitate communication between the various sites 203 – 208 in the telecommunications system 200. As mentioned above, the connectionless packet network 201 and the corresponding mappings in sites 203 – 208 provide a distributed architecture to improve mobility management (*i.e.*, monitoring the movement of subscribers as they move between sites in the telecommunications system).

Applicant submits, however, that the '347 patent does not suggest the desirability of including the connectionless packet network 201 in a localized system for monitoring industrial machines in a manufacturing plant as disclosed in the '491 patent. In the '491 patent, a means for communicating between the existing components (command station 6 and machine monitors 4) is already provided by wireless repeaters 8. Applicant notes that an additional communication means, such as connectionless packet network 201, is not necessary.

Furthermore, Applicant submits that the '491 patent teaches away from using a WAN and corresponding wireless communication protocol. As mentioned above, the local system disclosed in the '491 patent is used to transmit physical characteristics of industrial machines from monitors 4 (inside a manufacturing plant) to command station 8 (also inside manufacturing plant) via repeaters 8. In other words, the system requires **local** transmission and not transmission over a **wide** area network. Therefore, Applicant respectfully submits that the Office Action establishes no motivation or suggestion to combine the '347 patent and the '491 patent such as to render obvious independent claims 1, 8, 13, and 20.

Furthermore, because independent claims 1, 8, and 13, and 20 are believed to be allowable over the prior art of record, dependent claims 2 – 4 and 7 (which depend from independent claim 1), dependent claims 8 – 12 (which depend from independent claim 8), and dependent claims 14 – 16 and 19 (which depend from independent claim 13), and dependent claims 21 – 23 and 26 (which depend from independent claim 20) are allowable as a matter of

law for at least the reason that they contain all features and elements of the corresponding independent claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicant respectfully asserts that a prima facie case of obviousness has not been established and requests that the rejection of dependent claims 2 – 4, 7, 9 – 12, 14 – 16, 19, 21 – 23 and 26 be withdrawn.

B. Prima Facie Case of Obviousness Not Established: Combination Fails to Teach All Elements

Even assuming for the sake of argument that there is some proper suggestion or motivation to modify or combine the '491 patent and the '347 patent as the Examiner suggests, the combination of these references fails to disclose, teach, or suggest each and every element of independent claims 1, 8, 13, and 20. MPEP §2143.03.

The wireless communication networks of independent claims 1, 8, 13, and 20 are designed for “*monitoring and controlling a plurality of remote devices* via a host computer connected to a wide area network.” Unlike the wireless communication networks of independent claims 1, 8, 13, and 20, the localized systems taught in the '491 patent merely *monitor* physical characteristics, such as vibration or temperature, of industrial machines within a manufacturing plant. The '491 patent does not disclose, teach, or suggest the limitation of *controlling* the remote devices. Rather, the system merely responds to a polling request from the command station 6, senses the physical characteristic of the machine, and transmits the data to the command station 6. The '491 patent does not disclose, teach, or suggest controlling the remote devices. Furthermore, the cellular networks taught in the '347 patent clearly do not disclose, teach, or suggest *controlling* the mobile phones.

The wireless communication networks of independent claims 1, 8, 13, and 20 all *monitor and control* the remote devices, which is not disclosed, taught, or suggested by the

'491 patent and the '347 patent. Accordingly, and for at least this additional reason, Applicant respectfully submits that independent claims 1, 8, 13, and 20 patently define over the '491 and '347 patents and, therefore, should be allowed. Furthermore, because independent claims 1, 8, and 13, and 20 are believed to be allowable over the prior art of record, dependent claims 2 – 4 and 7 (which depend from independent claim 1), dependent claims 8 – 12 (which depend from independent claim 8), and dependent claims 14 – 16 and 19 (which depend from independent claim 13), dependent claims 21 – 23 and 26 (which depend from independent claim 20) are allowable as a matter of law for at least the reason that they contain all features and elements of the corresponding independent claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicant respectfully asserts that a prima facie case of obviousness has not been established and requests that the rejection of dependent claims 2 – 4, 7, 9 – 12, 14 – 16, 19, 21 – 23 and 26 be withdrawn.

V. Claims 5, 6, 17, 18, 24 and 25 are Patentable Over U.S. Patent No. 5,907,491 in view of U.S. Patent No. 6,141,347 and further in view of U.S. Patent No. 6,288,641

The Office Action rejects claims 5, 6, 17, 18, 24, and 25 under 35 U.S.C. §103(a) as being unpatentable over the '491 patent in view of the '347 patent and further in view U.S. Patent No. 6,288,641 to Casais ("the '641 patent). Without acquiescing to this argument, Applicant submits that this rejection is rendered moot in light of any of the arguments made above and, therefore, should also be withdrawn.

## CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 - 29 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

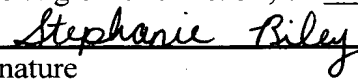


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